m-f

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,438	12/20/2001	Allison Stoltz	52493.000230	5099

21967 7590 11/02/2006

HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W.
SUITE 1200
WASHINGTON, DC 20006-1109

EXAMINER	
VAN DOREN, BETH	

ART UNIT	PAPER NUMBER
3623	

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/022,438	STOLTZ, ALLISON	
	Examiner	Art Unit	
	Beth Van Doren	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 October 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6,10-17 and 20-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6,10-17,20 and 22-24* is/are rejected.

7)☒ Claim(s) *21* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/18/2006 has been entered.

2. Claims 22-24 have bee added. Claims 1-6, 9-17, and 20-24 are pending in this application.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 6 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 recites the limitation "the number of questions presented". There is insufficient antecedent basis for this limitation in the claim. Claim 1 recites “a series of questions”, so this limitation has been construed as --the series of questions presented--. Clarification is required.

Claim 17 recites similar limitations to claim 6 and is therefore rejected under 35 USC 112, second paragraph, for the same reasons set forth above.

Allowable Subject Matter

5. Claim 21 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-6, 9-17, 20, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Barton et al. (U.S. 2002/0059093).

As per claim 1, Barton et al. teaches a method for use in compliance management, comprising:

presenting, via a computer network, at least one user with a series of questions relating to at least one business category (See figure 11, paragraphs 0010, 0012-4, 0049, 0051, wherein questions are presented via the network concerning compliance risk);

soliciting, via the computer network, a response from the at least one user for each question presented (See paragraphs 0010, 0012-4, 0049, 0051, 0060, wherein the questions are answered);

determining a detection index based on the number of responses to each of the series of questions (See paragraphs 0081 and 0084, wherein detection is determined);

determining an occurrence index based on the potential consequence of non-compliance (See paragraphs 0007, 0081, and 0084, wherein occurrence index is determined);

determining a standard severity risk index based on the expected severity of non-compliance (See paragraphs 0068, 0072-3, 0075, 0081, 0084, wherein severity indexes are considered); and

prioritizing, via the computer network, the at least one business category based on the at least one user's responses and at least one total risk score comprising the product of the detection, occurrence, and standard severity risk indices (See paragraphs 0081, 0084-7, wherein a risk score is calculated based on these factors. See also paragraphs 0068-9, 0072, 0081, 0090-1, where risk prioritization numbers are generated to determine the order to handle the risk areas of the business).

As per claim 2, Barton et al. discloses wherein the user response comprises a "Yes" or "No" (See paragraphs 0060 and 0064, wherein the questions are answered yes/no).

As per claim 3, Barton et al. discloses wherein at the least one standard severity risk index comprises a number between 1 and 10 corresponding to a specific level of risk (See paragraph 0060, 0068, 0072-5, wherein severity is valued 1-10).

As per claim 4, Barton et al. discloses wherein the number "1" comprises the lowest level of risk severity, and the number "10" the highest level of severity (See paragraph 0060, 0068, 0072-5, wherein 1 is low and 10 is high severity).

As per claim 5, Barton et al. teaches wherein the at least one standard severity risk index corresponds to the at least one business category (See paragraph 0040, 0060, 0068, 0072-5, which corresponds to at least one business category. See also figure 11).

As per claim 6, Barton et al. discloses the step of determining a detection index based on the at least one user's responses, and the number of users (See paragraphs 0065 and 0084, wherein the detection index is determined based on the responses from the at least one user). Barton et al. also generates a score based on the number of questions presented (i.e. "opps") (See paragraphs 0065 and 0084, where the number of questions presented (ie opportunities) are used to determine a score). However, Barton et al. does not expressly disclose using the number of questions presented to determine a detection index.

As per claim 9, Barton et al. teaches ranking the at least one business category based on the at least one total risk score (See paragraphs 0081, 0084-7, wherein a risk score is calculated. See also paragraphs 0068-9, 0072-5, 0081, 0090-1, where risk is prioritized).

As per claim 10, Barton et al. teaches a system for use in compliance management, comprising:

a query module associated with an engine for presenting at least one user with a series of questions relating to at least one business category, and for soliciting and receiving responses from the at least one user for each question presented (See figure 11, paragraphs 0010, 0012-4, 0049, 0051, 0060, wherein questions are presented via the network concerning compliance risk and answers are received);;

a prioritization module associated with the engine for: (1) determining a detection index based on the number of responses to each of the series of questions, determining an occurrence index based on the potential consequence of non-compliance, and determining a standard severity risk index based on the expected severity of non-compliances (See paragraphs 0068, 0072-3, 0075, 0081, 0084, wherein a detection, occurrence, and severity index are determined) and (2) prioritizing the at least one business category based on the at least one user's responses and at least one total risk score comprising the product of a detection, occurrence and standard severity risk indices (See paragraphs 0081, 0084-7, wherein a risk score is calculated based on these factors. See also paragraphs 0068-9, 0072, 0081, 0090-1, where risk prioritization numbers are generated to determine the order to handle the risk areas of the business).

As per claim 11, Barton et al. teaches wherein the series of questions are presented to the user over a communications network (See figure 11, paragraphs 0010, 0012-4, 0049, 0051, 0060, wherein questions are presented via the network).

As per claim 12, Barton et al. teaches wherein an administration module associated with the engine for inputting, updating and accessing data associated with the query and prioritization modules, the administration module being accessible to an administrator of the system via an administration interface (See paragraphs 0012-3, 0048-51, 0060, 0064, wherein an administrator and interface is disclosed).

Claims 13-17 and 20 recite equivalent limitations to claims 2-6 and 9, respectively, and are therefore rejected using the same art and rationale as applied above.

As per claim 22, Barton et al. teaches wherein the occurrence index weighs the total risk score based on the potential consequences of non-compliance (See paragraphs

0081, 0084-7, wherein a risk score is calculated based on these factors, and wherein occurrence influences and affects the overall score. See also paragraphs 0072 and 0075).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton et al. (U.S. 2002/0059093).

As per claims 23 and 24, Barton et al. teaches wherein an occurrence index and where the occurrence index represents the likelihood of occurrence and the frequency of non-compliance (See paragraphs 0081 and 0084-6). However, Barton et al. does not expressly disclose that the occurrence index is based on the total number of agents or employees affected by non-compliance or the total number of policies in force.

Barton et al. teaches an occurrence value that is indicated in the system and represents the likelihood of occurrence and the frequency of non-compliance. It is old and well known in the art that employees and the number of policies are factors that cause occurrences of non-compliance, such as a regulation being violated by a policy or an employee not following a rule. Therefore, it would have been obvious to one of oprdinary skill in the art at the time of the invention to consider employees affected by non-compliance and the total number of policies in force in the occurrence index of Barton et al. in order to more efficiently determine the potential for failure concerning the

business by taking into account the areas in which non-compliance events may occur. See paragraphs 0065 and 0084.

Response to Arguments

10. Applicant's arguments with regards to Barton et al. (U.S. 2002/0059093) have been fully considered, but they are not persuasive. In the remarks, Applicant argues that Barton et al. does not teach or suggest (1) "determining an occurrence index based on the potential consequence of noncompliance" because it does not recite a particular manner in which the index is determined, and (2) Barton et al. does not teach the particulars and specifics of claim 1, and that (3) that examiner has not established a prima facie case of obviousness with regards to claim 6, since Barton et al. does not expressly discloses using the number of questions presented to determine a detection index and that the modification presented by Examiner, even if obvious, would still fail to address the deficiencies of Barton et al.

In response to argument (1), Examiner respectfully disagrees. The claim recites, "determining an occurrence index based on the potential consequence of noncompliance", and thus the claim does not recite a specific manner in which the index is determined, but merely that it is based (i.e. being founded or established) on the potential consequences of noncompliance. Therefore, the recitation of "potential consequences of noncompliance" requires that the determined index is founded on or considers the fact that consequences of non-compliance occur, but does impart the requirement of a specific type of determination to occur.

Examiner further points out that in the broadest reasonable interpretation of the claim, the term "determining" could mean deciding on, discovering, or finding out,

without using a specific functional relationship. The last step of claim 1 recites that "at least one total risk score" comprises "the product of the detection, occurrence, and standard severity risk indices". Therefore, it seems that the interpretation of determining as "deciding on" is the most reasonable, since the manipulation of such a value occurs in the last step. Thus, the language "determining an occurrence index" merely requires setting a value in the system that reflects the value of the index. Without any recitation of how this is decided on, it could merely occur via solicitation of a value, in the broadest reasonable interpretation of the claim.

Barton et al. discloses identifying and quantifying compliance issues to assess potential risks, the issues involving failure modes and root causes that can be identified, mitigated, and controlled. Barton et al. specifically discusses constructing an FMEA matrix that includes a likelihood of occurrence factor, and using the rating system to calculate numbers using this occurrence factor, the numbers used to rank risks of noncompliance and recommend actions to reduce the risks. See at least paragraph 0081. See paragraph 0084 where occurrence is specifically calculated.

With regards to Applicant's remarks on page 8 of the response, arguing that Examiner's parenthetical statement of "See paragraphs 0007, 0081, and 0084, wherein the occurrence index is determined" reflects the inappropriate minimization of claim language, Examiner reminds applicant that the claims are rejected in light of the teachings of the prior art. Examiner provides such parenthetical statements as a mere guide for the Applicant to locate areas of the reference that specifically address each limitation. However, the limitation is rejected over the art and not over the summarized

statement of the examiner. Thus such statements do no serve to limit the teachings of Barton et al. as a whole, and Barton et al. does teach this limitation, as set forth above.

In response to argument (2), Applicant has argued that Barton et al. does not teach the particulars and specifics of claim 1. However, Applicant has not referred to specific claim language and explained how this specific claim language differs from the cited reference. Therefore, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

In response to argument (3), this argument has been considered but is moot in view of the new grounds of rejection set forth above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beth Van Doren whose telephone number is (571) 272-6737. The examiner can normally be reached on M-F, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

bvd
October 27, 2006

Beth Van Doren
Patent Examiner
AU 3623